



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/567,580

02/08/2006

Hakon Kofoed

246472009200

2494

25227 7590 10/23/2007

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

EXAMINER

WALKER, AMANDA H

ART UNIT

PAPER NUMBER

4134

MAIL DATE

DELIVERY MODE

10/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,580

Applicant(s)

KOFOED ET AL.

Examiner

Amanda H. Walker

Art Unit

~~3759~~ 4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a): In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2-08-2006.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: it does not include a subheading for "Brief Description of the Drawing".

Appropriate correction is required because the absence of this subheading would cause a printer error if it were to become a patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Franke (DE8812806U1).

Regarding Claims 1-3: The figures of Franke teach an ankle joint endoprosthesis (FIG.

1) with a lower component, an upper component, and an intermediate part (FIGS. 4-6).

The lower component slides with the intermediate part substantially non-rotatably

(arrows of FIG. 2), and the upper component interacts with the intermediate part

substantially rotatably (arrows of FIG. 2). The upper component has an upper

connection surface (21 of FIG. 15). The intermediate portion has a wedge shape

Art Unit: ~~3709~~ 4134

between the top and bottom surfaces in both the frontal and sagittal directions (FIGS. 2 and 3).

Regarding Claim 5: The figures of Franke teach that the wedge shaped component has a wedge part with a varying wedge angle (26 of FIG. 14) and a standard part (27 of FIG. 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franke (DE8812806U1) as applied to claim 1 and further in view of Groth, Jr. et al. (U.S. Patent No. 4,069,518).

The figures of Franke teach the basic claimed endoprosthesis as applied above.

Regarding Claim 4: The figures of Franke do not teach that the upper component and the intermediate part have a wedge angle of 1-16 degrees. However, Groth, Jr. et al. teaches that the upper component and the intermediate part have a wedge angle of 1-16 degrees (FIG. 5 and 2:35-40 and 2:60-68). Franke and Groth, Jr. et al. are combinable because they are from the same field of endeavor, namely, ankle prostheses. At the time of the invention, it would have been obvious to a person having

Art Unit: ~~3709~~ 4134

ordinary skill in the art to modify the intermediate and upper components taught by Franke with the wedge angle taught by Groth, Jr. et al., and one would have been motivated to do so in order to provide a more stable bearing surface.

Regarding Claim 7: The figures of Franke teach that the wedge shaped component has a wedge part with a varying wedge angle (26 of FIG. 14) and a standard part (27 of FIG. 14).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franke (DE8812806U1) in view of Elloy et al. (U.S. Patent No. 4,904,269).

The figures of Franke teach an ankle endoprosthesis set comprising a lower component, an upper component, and an intermediate part with all of the claimed slide surfaces and relating interactions (FIGS. 1 and 2). The upper component has an upper connection surface (21 of FIG. 15). Franke also teaches a set of normal upper and intermediate components in which the top and bottom faces are substantially parallel (FIGS. 5, 8 and 9).

The figures of Franke don't teach a wedge shaped corrective component. However, Elloy et al. teaches a wedge shaped corrective component (3:60-65 and FIGS. 5 and 6). Franke and Elloy et al. are combinable because they are from the same field of endeavor, namely, joint prostheses. At the time of the invention, it would have been obvious to a person having ordinary skill in the art to modify the ankle prosthesis of Franke with the wedge shaped corrective component taught by Elloy et al., and one would have been motivated to do so in order to relocate downward forces, thus

Art Unit: ~~3709~~ 4134

increasing patient comfort and surgical success (3:40-45). The respective planes and faces affected by the modification would be implicit.

The figures of Franke also don't teach that the system includes a plurality of sets of prostheses. However, Elloy et al. teaches a joint prosthesis system with sets of corrective components (3:60-65 and FIGS. 5 and 6). At the time of the invention, it would have been obvious to a person having ordinary skill in the art to modify the singular implant taught by the figures of Franke with the kit and corrective components taught by Elloy et al., and one would have been motivated to do so to provide convenience to the surgeon and the best fit for the patient.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franke (DE8812806U1) as applied to claim 1 and further in view of Groth, Jr. et al. (U.S. Patent No. 4,069,518) and Hollister (U.S. Patent No. 5,133,758).

The figures of Franke teach the basic claimed endoprosthesis as applied above.

The figures of Franke do not teach that the intermediate part has a wedge angle of 3-8 degrees. However, Groth, Jr. et al. teaches that the intermediate part has a wedge angle of 3-8 degrees (FIG. 5 and 2:35-40 and 2:60-68). At the time of the invention, it would have been obvious to a person having ordinary skill in the art to modify the intermediate and upper components taught by Franke with the wedge angle taught by Groth, Jr. et al., and one would have been motivated to do so in order to provide a more stable bearing surface.

Art Unit: 3709 4134

The figures of Franke also do not teach that the upper component has a wedge angle of 3-8 degrees. However, Hollister teaches an upper component of a joint prosthesis that has a wedge angle of 3-8 degrees (8:15-20 and FIG. 9). Franke and Hollister are combinable because they are from the same field of endeavor, namely, joint prostheses. At the time of the invention, it would have been obvious to a person having ordinary skill in the art to modify the upper component taught by Franke with the wedge angle of 3-8 degrees taught by Hollister to provide a bone ingrowth and connection surface which accommodates the natural bone structure of the specific patient.

Other prior art considered applicable to the instant claims but not used in these rejections can be found in the enclosed document entitled "Notice of References Cited".

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda H. Walker whose telephone number is (571)270-3296. The examiner can normally be reached on 9-4, M-Th, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: ~~3700~~ 4134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHW
10-2-07



MARK EASHOO, PH.D.
PRIMARY EXAMINER

13/04/07